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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,930	09/05/2003	Martha Kelsey	P07667US01	8622
22885	7590	11/14/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			DOAN, ROBYN KIEU	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,930

Applicant(s)

KELSEY, MARTHA

Examiner

Robyn Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's Amendment filed 8/24/2006 has been entered and carefully considered. Claims 1, 4-6 and 14 have been amended. New claims 16-20 have been added. Limitations of new and amended claims have not been found to be patentable over newly discovered prior art, therefore, claims 1-20 are rejected under the new ground rejections as set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 6, 14 and 18 recite "repeatedly self-adherent", the term "repeatedly" is considered as new matter because the original disclosure does not disclose such limitation; also, while the original disclosure taught the device is self-adherent, it is not necessary that the device being repeatedly self-adherent.

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Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 6, 14 and 18 recites the material being repeatedly self-adherent but not securely adherent to skin or hair and resiliently stretchable. There is no teaching how to make the material being repeatedly self-adherent but not securely adherent to skin or hair and resiliently stretchable in the original disclosure, also, it is unclear how the stretchable material can be repeatedly adherent and at the same time not be securely adherent to the skin or hair and it would take an undo experimentation to figure out how the stretchable material being repeatedly self-adherent but not secure to the skin or hair.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Morgenstern

(U.S. Pat. # 6,545,193).

With regard to claim 16, Morgenstern discloses a device inherently for body and hair accessorizing (figs. 1-3) comprising a strip of material (12) having a first (22) and a second side (48), a first (18) and a second end (20), an adhesive (30) disposed on at least one side (22) of the material, the material also being resilient stretchable (elastic, col. 4, line 65), repeatedly self adherent (Applicant is noted that the strip of material has loop and hooks 24, 26 and 40, 42 on both sides, therefore the loop and hooks being repeatedly self adherent) but not securely adherent to the skin and wrappable and conformable to itself (col.5, lines 30-45 shows the material 12 being wrapped around the user's body using the loop and hook fasteners), wherein the strip being capable to surround the body part of the user such that the first and second ends inherently engaged to secure the strip to the body part.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgenstern.

With regard to claim 17, Morgenstern discloses a device including all the claimed limitations in claim 16 as discussed above except for one separate shape adapted for selective attachment to the strip of the material. Morgenstern discloses another embodiment which shows the strip of material (1102, fig. 28) further having a separate shape (1116, fig. 28) adapted for selective attachment to the strip of the material. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the separate shape as taught by another embodiment of

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Morgenstern into the device of Morgenstern as discussed above for the purpose of covering the sides of the strip.

Claims 1-3, 6-15, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aboud (U.S. Pat. # 5,338,290) in view of Augst et al (U.S. Pat. # 5,616,387).

With regard to claims 6, 9 and 10, 13, Aboud discloses a device for wrapping around the body (fig. 1) comprising one strip of material (middle strip 11, fig. 1) having a first and second side, the strip including a first and second end (14) and adhesive (col. 4, lines 56-64) disposed on at least one side of the material, the material being repeatedly self-adherent but not securely adherent to skin or hair (Applicant is noted that the material is repeatedly self-adherent because of the fasteners at both ends being made of Velcro, therefore it being repeatedly self-adherent but not securely adherent to skin or hair), resiliently stretchable (col. 4, lines 25, 26) and wrappable and conformable to a body part of the user (see fig. 3a), wherein the strip being adapted to surround the body part such that the first end and the second end engage to secure the strip (fig. 2) by using a fastener (12a, b) to the body part of the body (see fig. 3a). Aboud fails to show the strip of material being made from a perforated roll of rubber material, however, Augst et al discloses a roll of perforated, elastic wrap (fig. 1) for wrapping around a body of a user having a plurality of strips (80), each of the strips attached to one another by perforated line (60); the material of the roll being made of rubber latex (col. 5, lines 53, 54). It would have been obvious to one having an ordinary skill in the art at the time the

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invention was made to modify the strip of material of Aboud with the roll as taught by Augst et al for the purpose of reducing the cost of manufacture by providing a large quantity of strips in a roll form. In regard to claim 7, Aboud further shows the adhesive on the first and second sides of the material (Applicant is noted that in order for the two strips can attach to the middle strip 11 as described in the fig. 1, the middle strip 11 must have adhesive on both sides of the strip). In regard to claim 8, Aboud inherently shows the adhesive being integral to the material. In regard to claims 11, 14, 15, 18, 19, Aboud in view of Augst et al discloses a first roll of self adhesive perforated rubber material comprising all the claimed limitations in claim 1 as discussed above except for a duplicate second roll having a color different than the first roll. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct a duplicate second roll of material, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. And It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct a color of the second roll being different than the first roll, since such a modification would have involved a mere color change in the known component. In regard to claim 12, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ self-adhesiveness properties to the first and second ends of the material, since such modification is well known in the art. In regard to claim 20, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the strips of material of the first and second roll being different in

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shape, since such a modification would have involved a mere change in the shape of the non known component. A change in shape is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). In regard to claim 1, as discussed above, Aboud in view of Augst et al will perform the method recited in the claims during normal operational use of the device. In regard to claim 2, Aboud in view of Augst et al inherently show stretching the strip into tension. In regard to claim 3, Aboud in view of Augst et al inherently show at least partially unrolling the roll of material.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aboud in view of Augst et al as applied to claim 1 above, and further in view of Scheggetman.

With regard to claims 4-5, Aboud in view of Augst et al disclose a method for wrapping a strip of material into the user's body comprising all the claimed limitations in claim 1 as discussed above except for the steps of cutting at least one manipulative piece from a second roll of material, wherein the second roll differs in color than the first roll and placing the manipulative piece onto the strip of the first roll. Scheggetman discloses a method of applying one manipulative piece to a roll (fig. 1) comprising a step of cutting at least one manipulative piece (10) from a roll (12, col. 2, line 3) and placing the manipulative piece onto a surface of a second roll (14, fig. 1). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the steps of cutting at least one manipulative piece from a roll of material and

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placing the manipulative piece onto the strip of the second roll as taught by Scheggetman onto the surface of the strip of Aboud in view of Augst et al for the purpose of providing a release layer to the strip. Also, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the second roll being made of different colors than the first roll, since such a modification would have involved a mere change in the color of the non critical component. A change in color is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Robyn Doan', with a long horizontal flourish extending to the right.

Robyn Doan
Examiner
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